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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,322

03/16/2005

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CU-4060 BWH

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26530 7590 10/26/2009  
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EXAMINER

CHAWLA, JYOTI

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,322	<b>Applicant(s)</b> LUTZ ET AL.	
	<b>Examiner</b> JYOTI CHAWLA	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 5/22/09 & 6/24/2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-63 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Applicant's submission filed on 5/22/09 and supplemental amendment of 6/24/09 has been entered as compliant. Claims 39-40, 45-46 have been amended. Claims 33-63 are pending and examined in the current application.

#### ***Claim Objections***

Objection of claim 63 has been withdrawn based on applicant's amendment to claim 63, dated 5/22/09 correcting the spellings of "rebaudiana".

#### ***Claim Rejections - 35 USC § 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicants' statement that "the terms "an extract of a mixture of herbs" and a "mixture of herb extract" may indeed be deemed being in some way or the other equivalent" (Remarks of 5/22/09, page 7, lines 20-24) clarifies that the two terms are equivalent. Thus, rejection of claims 33-63 under 35 U.S.C. 112, second paragraph, as being indefinite for the recitation of phrases "herbal mixtures comprising an extract of a mixture of herbs" or "a mixture of herb extracts" in the claims (e.g., claims 33 and 34 respectively) have been withdrawn based on applicant's explanation (Remarks Page 7 "Rejections under 35 USC 112", filed 5/22/09).

Rejection of claims 45 and 46 has also been withdrawn based on applicants' amendment dated 6/24/09.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(A) Claims 33-52, and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirschner et al (US 6352713 B1), hereinafter Kirschner, in view of Zhao (2002/0132037).

References and rejections are incorporated herein and as cited in the previous office action dated 2/23/2009.

Applicants' amendment to claims 45 and 46 dated 6/24/09 changed the dependence of claim 45 (now depending from claim 37) and claim 46 (which now depends from claim 38). However, since claims 33-52 and 57-60 (which includes claims 37-38 and claims 45-46) were rejected over Kirschner in view of Zhao, the rejections made in the previous office action are sustained for the reasons of record.

(B) Claims 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirschner in view of Zhao as applied to claims 33-34 and 37-38, further in view of Bell et al (US 5338809), hereinafter Bell.

Kirschner in view of Zhao has been relied upon to reject claims 33-34 and 37-38 as discussed above.

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References and rejections are incorporated herein and as cited in the previous office action dated 2/23/2009.

(C) Claims 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oppenheimer et al (US 4980169), hereinafter Oppenheimer, in view of the combination of Kirschner (US 6352713 B1) and Zhao (2002/0132037).

References and rejections are incorporated herein and as cited in the previous office action dated 2/23/2009.

### ***Response to Arguments***

Applicant's arguments with respect to claims 33-63 have been considered but have not been found persuasive.

i) Applicants argue that “all of the cited prior art references are drawn to products that are fundamentally different from those of the present invention” (Remarks, dated 5/22/09, Page 10, lines 16-18). Applicants seem to arrive at this conclusion because, “Kirschner teaches chewable prenatal nutrition supplements containing vitamin C and, optionally, folic acid, minerals, other vitamins and/or additives” (Remarks, dated 5/22/09, page 8, lines 6-7 and page 10, lines 18-20); “Zhou teaches an herbal sweetener composition which is low in calories and ideal for use as substitute for refined sugar or sucrose”.

Applicants' arguments against Kirschner and Zhao are not persuasive for the following reasons:

First of all, applicants are referred to the rejected claims as recited, e.g., claim 33 recites “A confectionery article in non-liquid form based on herbal mixtures comprising an extract of a mixture of herbs and an extract of Stevia rebaudiana wherein the herbs are peppermint, sage yarrow and thyme.” (Emphasis added). Thus, the invention as claimed in a confectionery article comprising herb extract of a mixture of herbs (i.e., peppermint, sage, yarrow and thyme) and an extract of Stevia rebaudiana. The

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recitation of open ended term “comprising” in claims means that relevant prior art or combination of prior art references can be a confection which includes the recited ingredients along with other ingredients without limitation.

Secondly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In the instant case, **Kirschner** teaches a nutritional composition that can be a confection (Column 8, lines 59 to Column 9, line 1, see specifically, line 65 of Column 8) in a non liquid form (Column 8, lines 59-60) based on herbal mixtures comprising an extract of a mixture of herbs, or a mixture of herb extracts (Column 13, lines 54-57) wherein the herbs are peppermint, sage, yarrow and thyme (Column 13, lines 24-54). Thus, Kirschner teaches of the herb extracts as instantly claimed, which is also confirmed by applicants' remarks on Page 8, paragraph 2.

Regarding extract of *Stevia rebaudiana*, Kirschner discloses that the confectionery article may include sweetener (Column 13, lines 63 and Column 14, lines 14-20) but does not disclose that the article also comprises “an extract of *Stevia rebaudiana*”. **Zhao** teaches the use of an extract of *Stevia rebaudiana* as a sweetener confectionary articles (page 1, paragraph 0014, last sentence and paragraph 0019; also page 2, paragraph 0021). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kirschner such that the confectionary article also comprises an extract of *Stevia rebaudiana*. One of ordinary skill would have been motivated to modify Kirschner at least for the purpose of providing a natural sweetener that has the known benefit of providing sugar sweet taste without elevating blood glucose level (page 2, paragraph 0021, last sentence).

Applicants' argument against Bell is that “Bell is labeling *Stevia rebaudiana* component which may be present as sweetener as “Stevioside”, which any person skilled in the art

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considers as highly pure synthetic sweetener, as opposed to the extract of *Stevia rebaudiana* which is a major and central ingredient of the herbal communication of the invention” (Remarks of 5/22/09, Page 9, lines 18-22 and page 10, lines 16-24).

Applicants argument is not persuasive and applicants are once again referred to *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), wherein, it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, Bell is being relied upon in an obviousness rejection, in combination with Kirschner and Zhao, wherein Zhao is relied on for inclusion of extract of *Stevia rebaudiana* (e.g., for claim 33) and not Bell as argued by the applicant. Claims 53-56 recite a chewing gum type confection. Kirschner in view of Zhao teaches substantially the claimed composition but does not specifically state that that the confectionary article may be in the form of “a chewing gum”. However, chewing gums with herbal extracts and *Stevia* extracts were known at the time of the invention, as taught by Bell (column 4, lines 37-38 and 56-61), i.e., Bell is relied upon to show the conventionality of a confection with herb extracts can be in the form of a chewing gum. Therefore, it would have been obvious for one of ordinary skill at the time of the invention to further modify Kirschner and make a gum based confection with herb extracts including the extract of *Stevia*, as taught by Bell. One would have been motivated to do so at least for the purpose of making the chewable confection of Kirschner last longer and make it available in a form (i.e., chewing gum form) according to consumer preference.

Applicants’ argument against Oppenheimer is “Oppenheimer teaches a composition containing a volatile oil and a volatile oil-modifying agent” (*See Remarks, dated 5/22/0, page 10, lines 16-24*), and thus does not teach applicants’ invention as claimed. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

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1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case applicants are referred to the rejection of claims 61-63 over Oppenheimer in view of the combination of Kirschner and Zhao. Oppenheimer teaches a method of producing a confectionery article comprising the extract of herbs (plant extracts, Column 6, lines 10-15), with extract of *Stevia rebaudiana* (Column 6, line 45 as a sweetener) and processing the resultant mixture into a confectionery article of the desired form (Column 4, line 33 to Column 6, line 15). Oppenheimer further teaches that making confections is a well known art and provides method steps for making hard, soft, chewable type confections comprising extracts from plants (herb extracts) where the sweeteners and additives are heated to reach desired consistency (thickening) before addition of additives, such as, flavoring including herbal extracts (Column 4, line 33 to Column 6, line 15). Oppenheimer also teaches of processing the resultant mixture of sweetener and flavor extracts into confectionery article of desired form (Column 5, lines 18-23). Further, Kirschner and Zhao teach a confectionery product that may be a confectionary article (Column 8, lines 59 to Column 9, line 1) in a non liquid form (Column 8, lines 59-60) based on herbal mixtures comprising an extract of a mixture of herbs, or a mixture of herb extracts (Column 13, lines 54-57) wherein the herbs are peppermint, sage, yarrow and thyme (Column 13, lines 24-54) with "an extract of *Stevia rebaudiana* (Zhao, page 1, paragraph 0014, last sentence and paragraph 0019; also page 2, paragraph 0021). Kirschner teaches herbal extracts and combinations thereof including extracts of peppermint, sage, yarrow, and thyme as taught by Kirschner (Column 13, lines 24-57) as instantly claimed. Thus, Oppenheimer teaches of the claimed step of obtaining the extract.

Thus, methods of making confections comprising herbal extracts were known in the art at the time of invention (Oppenheimer). Herbs such as, peppermint, sage, thyme and yarrow were also known to be used together (Kirschner). Sweetener or extract derived from *Stevia* was also well known as a sweetener for confections at the time of the invention (Zhao and Oppenheimer). Therefore, it would have been a matter of routine determination for one of ordinary skill in the art at the time of the invention to modify Oppenheimer in view of the combination of Kirschner and Zhao at least for the purpose



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of providing a herbal confection that also contains a natural sweetener that has the known benefit of providing sugar sweet taste without elevating blood glucose level (page 2, paragraph 0021, last sentence). One would have been further motivated to use either herbs or their extracts based on the availability of time, e.g., addition of prepared extracts will shorten the production time.

ii) In response to applicant's argument that "Zhou's product contains, as its main components, naturally occurring sugars and terpene glycosides, such as extracts from herbs, inter alia, *Stevia rebaudiana*, which are present therein and deemed as important ingredients, cannot be, notionally, "incorporated" into the invention of Kirschner, thus "filling the gap" which is left open therein." (See Remarks, dated 5/22/09, page 8 last paragraph to page 9, paragraph 1), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

iii) Applicants also argue that "These references mention certain herbs and/or *Stevia rebaudiana*, mostly only parenthetically, rather than naming them as major and central ingredients" (Remarks, page 10, lines 24-26). Applicants also state that "the extract of *Stevia rebaudiana* which is a major and central ingredient of the herbal communication of the invention" (See Remarks of 5/22/09, page 10, lines 6-8). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "herbs and/or *Stevia rebaudiana*... naming them as major and central ingredients" and "the extract of *Stevia rebaudiana* which is a major and central ingredient of the herbal communication of the invention") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Keith D. Hendricks/  
Supervisory Patent Examiner, Art Unit 1794

/JC/  
Examiner  
Art Unit 1794